

Image

01-12-04

1646

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Ward *et al.*

Group Art Unit: 1646

Serial No.: 10/070,007

Examiner: Andres, Janet L.

Filed: October 10, 2002

Confirmation No. 5750

For: TRUNCATED EGF RECEPTOR

CERTIFICATE OF MAILING		
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage for Express Mail in an envelope addressed to:		
Mail Stop, Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450		
January 9, 2004 Date	 N. Kemper	EV 412 172 193 US Express Mail Tracking No.

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated December 11, 2003, Applicants respectfully request reconsideration of the finding of a lack of unity of invention in light of the following arguments.

The Patent Office has requested restriction under 35 U.S.C. § 121 between four allegedly distinct claim groups:

Group I: Claims 23-44, 48-51, 53, and 54, drawn to proteins, classified in class 530, subclass 350;

Group II: Claims 45-47 and 52, drawn to polynucleotides and means of expression, classified in class 435, subclasses 69.1, 320.1, and 325, and class 535, subclass 23.5;

Group III: Claim 55, drawn to a method of screening, classified in class 435, subclass 7.1;

Group IV: Claims 56 and 57, drawn to methods of treatment, classified in class 514, subclass 2.

Applicants provisionally elect with traverse the claims of Group I for examination and request reconsideration of the restriction requirement in view of the following arguments.

Applicants submit that the restriction requirement in the present application is improper. The Examiner states that the inventions I and II are unrelated based on the rules set forth in MPEP 806.04 and MPEP 808.01. Considering that the present application was filed as a PCT application and entered the national stage in the United States, the unity of invention issue should be determined by PCT practice as set out in MPEP 1893.03.

According to the PCT practice guidelines, a group of inventions is considered to form a single inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding technical feature. The present case represents the very example of this in that the Group I and Group II claims share a special technical feature. Specifically, the Group II claims are directed to polynucleotides encoding the truncated EGFR ecodomains as defined in the Group I claims. Therefore, the claims of Groups I and II are technically linked.

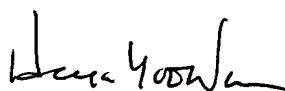
Annex B to the Administrative Instructions under the PCT, Part 2, "Examples Concerning Unity of Invention", further provides appropriate guidance for the present case. Specifically, Example 17 therein relates to a claim 1 drawn to a "Protein X" and a claim 2 drawn to a "DNA sequence encoding protein X". The guidelines clearly state that "Expression of the DNA sequence in a host results in the production of a protein which is determined by the DNA sequence. The protein and the DNA sequence exhibit corresponding special technical features. Unity between claim 1 and claim 2 is accepted". This example is directly applicable to the present case.

Applicants further submit that the claims of Group III and Group IV also share a common technical feature with the claims of Group I. More specifically, claim 55 of Group III defines a method of screening a compound using the EGFR molecule defined in claim 23 (Group I). Similarly, claims 56 and 57 (Group IV) define methods that involve the use of the EGFR molecules defined in the Group I claims. Therefore, the claims of Groups I, III, and IV are linked by a common technical feature and should thus be examined together.

Based on the foregoing arguments, Applicants respectfully request reconsideration of the present restriction requirement and examination of all the claims in the present application simultaneously. At a minimum, the claims of Groups I and II (claims 23-54) should be examined together based on the common technical link. Because of the shared common technical feature as pointed out above, it would not cause extra burden to the Patent Office.

It is believed that this submission does not require the payment of any fees. However, if this is incorrect, please charge any deficiency or credit any overpayment to Deposit Account No. 07-1969.

Respectfully submitted,



Heeja Yoo-Warren
Reg. No. 45,495

GREENLEE, WINNER AND SULLIVAN, P.C.
5370 Manhattan Circle, Suite 201
Boulder, CO 80303
Telephone: (303) 499-8080 / Facsimile: (303) 499-8089
E-mail: winner@greenwin.com
Attorney Docket No. 7-02
nk: January 9, 2004